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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,390	08/28/2001	Shane Chen	BWD:7945.006	6029

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EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/941,390

**Applicant(s)**

CHEN, SHANE

**Examiner**

Frank Vanaman

**Art Unit**

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32, 42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3618

### **Status of Application**

1. Applicant's response, filed Feb. 10, 2004, has been entered in the application. Claims 32, 42 and 43 are pending.

### **Claim Rejections 35 USC 102**

2. The portions of 35 USC relied on herein may be found in a previous office action.
3. Claims 32, 42 and 43 are rejected under 35 USC 102(e) as being anticipated by Parks (US 6,531,838, cited previously. Parks teaches a scooter having a running board (11) supported by front (23) and rear (12) wheels, the front wheel being connected to a handle bar (22) by a steering shaft (21), a motor assembly (27) detachably coupled to the shaft by a clamp (46, 47, 48) which may be loosened and slid along the shaft (to the extent allowed by the diameter of the shaft and the notch 30), a battery case (40), a motor (35) with an output shaft (44) and further including a biasing mechanism (38) which urges the motor shaft into contact with the front wheel periphery, the biasing element taught to optionally be a spring tensioner (see col. 3, lines 12-13 and col. 5, lines 3-9) wherein a further battery case (40) may be provided directly above the motor (see col. 4, lines 21-22) resulting in the biasing device (which may be provided as a spring) being located between the case and motor, the assembly further including an outer case (50, see col. 3, lines 36-40) which houses the battery case(s) and motor and which may be slid with respect to the clamp (46, 47, 48) when it is disengaged from the assembly, to the breadth claimed.

### **Response to Comments**

4. Applicant's comments have been carefully considered. as regards the reference to Parks and the provision of a spring between the motor and battery case, applicant is reminded of the following: Parks includes this feature in that (1) the reference anticipates providing a further battery element (as referred to at col. 4, lines 21-22) which would locate it above the motor, and (2) Parks anticipates the provision of spring tensioner devices in place of the threaded elements 38 (as specifically taught at Parks in col. 3, lines 12-13 and col. 5, lines 3-9). These citations were provided in the previous office action in the statement of rejection. As such, the teachings specifically pointed out above (and specifically pointed out to the same degree of detail in the previous office

Art Unit: 3618

action) support the examiner's position. Applicant is reminded that the drawings of a Patent document alone may not show every element that is actually part of the disclosure of a Patent document.

5. Note that the use of a spring tensioner (anticipated by Parks at col. 3, lines 12-13 and col. 5, lines 3-9) and the provision of a second battery element on the opposite side from the specifically illustrated element (anticipated by Parks at col. 4, lines 21-22) would result in the provision of a spring tensioner located between the battery case and the motor. Applicant is reminded that a recitation of a device "interacting between" two elements does not encompass any degree of relationship beyond that which is actually positively recited, and that it is not proper for an examiner to read un-recited limitations into a claim.

Limitations not in the claims

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As regards reading unclaimed limitations from the specification into the claims

From MPEP 2111: During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)

Art Unit: 3618

Applicant's comments about the battery and motor being slidable with respect to the clamp are noted, but it appears that the recitation in claim 43 is directed to a case which houses both a battery and a motor and may be slid with respect to a clamp. Note that Parks' case (50) encloses both the motor and battery, and may be slid, to the breadth claimed, with respect to the clamp, or the motor or the battery, once it is unmounted therefrom.

### Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

As of May 1, 2003, any response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450,

Or faxed to one of the following fax servers:

Regular Communications/Amendments: 703-872-9326  
After Final Amendments: 703-872-9327  
Customer Service Communications: 703-872-9325

**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**



4/26/04